

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB                      AUG. 24, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Allergan, Inc.  
v.  
Whit H. Smith

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Opposition No. 99,308 to application Serial No. 74/574,534  
filed on September 16, 1994

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Kenneth L. Wilton of Small Larkin, LLP for Allergan, Inc.

Whit H. Smith, pro se.

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Before Hohein, Walters and Wendel, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by Whit H. Smith to  
register the mark "AQUA" for "liquid bath and toilet soap".<sup>1</sup>

Registration has been opposed by Allergan, Inc. on the  
ground that opposer, "under its marks AQUA GLYCOLIC, AQUA GLYDE,  
AQUA LACTEN Stylized and AQUAMED and its other marks ('Opposer's  
Marks'), has become well-known for its skin care, personal  
hygiene and cosmetic products"; that "Opposer's Marks constitute

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<sup>1</sup> Ser. No. 74/574,534, filed on September 16, 1994, which alleges a  
bona fide intention to use the mark in commerce.

a family of marks in connection with said products with the term 'Aqua' being the distinguishing and common feature of this family of marks"; that opposer, by assignment from its predecessor-in-interest, Herald Pharmacal, Inc., is the owner of valid and subsisting registrations for the following marks and goods:

(1) the mark "AQUA GLYCOLIC" for "skin moisturizing lotion; [and] non-medicated shampoo";<sup>2</sup>

(2) the mark "AQUA GLYDE" for "skin cleanser";<sup>3</sup>

(3) the mark "AQUA LACTEN," depicted in the stylized format shown below,

for "hand lotion";<sup>4</sup> and

(4) "AQUAMED" for "skin lotion";<sup>5</sup>

that "[t]here is no issue as to priority" inasmuch as the filing date of applicant's intent-to-use application is "subsequent to the issuance of all of Opposer's [registrations for its] pleaded registered marks"; and that applicant's mark "so resembles

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<sup>2</sup> Reg. No. 1,704,479, issued on August 4, 1992, which sets forth dates of first use of December 6, 1983; combined affidavit §§8 and 15. The word "GLYCOLIC" is disclaimed.

<sup>3</sup> Reg. No. 1,501,845, issued on August 30, 1988, which sets forth dates of first use of August 2, 1985; combined affidavit §§8 and 15.

<sup>4</sup> Reg. No. 1,058,876, issued on February 15, 1977, which sets forth dates of first use of June 11, 1976. Such registration, however, has expired for failure to renew and thus proof of ownership thereof would not avoid the issue of priority of use of the subject mark.

<sup>5</sup> Reg. No. 1,516,947, issued on December 20, 1988, which sets forth dates of first use of November 30, 1965; combined affidavit §§8 and 15.

**Opposition No. 99,308**

Opposer's Marks as to be likely, when applied to the goods of Applicant, to cause confusion or mistake or to deceive".

Applicant, in his answer, has denied the salient allegations of the opposition. Applicant also states therein that "AQUA" is "a word common in the [E]nglish language and research shows that over 600 trademarks have been registered using the word aqua, including [registrations for] soap, skin cleanser, liquid soap, etc."

The record consists of the pleadings, including, as attachments to the opposition, reasonably contemporaneous certified copies of opposer's pleaded registrations showing that, as of the three months preceding the filing of the opposition, such registrations were subsisting and owned by Herald Pharmacal, Inc.; the file of the opposed application; and, as opposer's case-in-chief, the testimony, with exhibits, of Joseph A. Lewis, who is the director of research and development for opposer's cosmetic and other over-the-counter products. Applicant, however, did not take testimony or otherwise introduce any evidence on his behalf. Briefs have been filed, but an oral hearing was not requested.

Opposer's priority of use of its pleaded "AQUA GLYCOLIC," "AQUA GLYDE" and "AQUAMED" marks is not genuinely in issue inasmuch as the testimony of Mr. Lewis establishes that, as confirmed by the copy of the assignment thereof, opposer's registrations for such marks and the marks themselves, together with the goodwill appurtenant thereto, were indeed assigned to opposer by its predecessor-in-interest, Herald Pharmacal, Inc.,

about two months prior to the filing of the opposition. Thus, and in light of the certified copies of such registrations which accompany the opposition, opposer has proven that it is in fact the owner of subsisting registrations for such marks. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The record, in any event, establishes that opposer is the prior user of those marks and, although the stylized format thereof has been discontinued, opposer is also the prior user of its "AQUA LACTEN" mark.<sup>6</sup> The only real issue to be determined, therefore, is whether applicant's "AQUA" mark, when used in connection with liquid bath and toilet soap, so resembles one or more of opposer's "AQUA GLYCOLIC," "AQUA GLYDE," "AQUA LACTEN" and "AQUAMED" marks for, respectively, its skin moisturizing lotion and shampoo, skin cleanser, hand lotion, and skin lotion, that confusion is likely as to the origin or affiliation of the parties' goods.<sup>7</sup>

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<sup>6</sup> Applicant, having failed to take testimony or otherwise present any evidence in his behalf, is limited to the September 16, 1994 filing date of his application as the earliest date on which he can rely in this proceeding. See, e.g., Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974) and Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960).

<sup>7</sup> Although opposer, as noted previously, has pleaded a family of "AQUA"-prefixed marks and indicates in its brief that it "believes the evidentiary record supports a finding that Opposer owns a family of AQUA- marks," opposer further states therein that "the Board need not reach this conclusion in order to find that Applicant's mark is likely to confuse." We observe, in this regard, that as stated in J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991):

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a

According to the record, opposer acquired Herald Pharmacal, Inc. ("Herald") in August 1995 by purchasing the major assets of such firm, including its manufacturing facilities, products and trademarks. Opposer's witness, Mr. Lewis, who became employed by opposer at the time of its acquisition of

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series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. ....

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

Contrary to the allegation in the opposition and in opposer's brief, it simply cannot be said on this record that opposer has demonstrated the existence of a family of "AQUA"-formative marks, particularly among the general public. Although opposer's marks are listed together in sales sheets, order forms, product catalogs and price lists, nothing therein is indicative of the promotion of such marks as a family characterized by the prefix "AQUA," especially since various other marks for additional products marketed by opposer are also set forth. The materials, moreover, are directed solely to the drug wholesalers and pharmacy customers of opposer and, thus, can scarcely be said, as stated in opposer's brief, to constitute "uncontroverted evidence that Opposer's promotional materials ... were distributed to the general public". The evidence, in short, simply fails to show that opposer's marks have been promoted in any manner sufficient to create a recognition or awareness among the general public, or even among opposer's direct customers, of the common ownership thereof so that a family of marks, characterized by the term "AQUA" as its distinguishing element, in fact exists. See, e.g., La Maur, Inc. v. Bagwells Enterprises, Inc., 199 USPQ 601, 606 (TTAB 1978) and Polaroid Corp. v. American Screen Process Equipment Co., 166 USPQ 151, 154 (TTAB 1970). Furthermore, the mere ownership of a number of marks sharing a common feature, or even ownership of many registrations therefor, is alone insufficient to demonstrate that a family of marks exists. See, e.g., Hester Industries, Inc. v. Tyson Foods, Inc., 2 USPQ2d 1646, 1647 (TTAB 1987); Consolidated Foods Corp. v. Sherwood Medical Industries Inc., 177 USPQ 279, 282 (TTAB 1973); Polaroid Corp. v. American Screen Process Equipment Co., supra; and Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419, 421 (CCPA 1965). Accordingly, inasmuch as opposer has not established its assertion of a family of "AQUA"-based marks, the issue of likelihood of confusion must be determined by comparing applicant's mark for his goods with each of opposer's marks for its various products.

Herald, was prior thereto the executive vice president of such firm as well as a director and major shareholder. After joining Herald, which was founded in the early 1960s, as a chemist in March 1979, Mr. Lewis became the person responsible for the development of its new products. Moreover, in addition to being in charge of marketing those products, he was also in charge of selecting the trademarks under which Herald's goods were to be sold.

While so employed at Herald, Mr. Lewis developed and launched a skin cleanser which was first sold under the mark "AQUA GLYDE" in 1985. Such mark has been in continuous use for skin cleanser "until just recently," when "[t]hey changed the name to Aqua Glycolic".<sup>8</sup> (Lewis dep. at 12.) The "AQUA GLYDE" product, while sold over-the-counter to the general public, was principally marketed by having Herald's sales representatives distribute product samples thereof to physicians, who in turn would recommend such skin cleanser to their patients for purchase at drug stores.

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<sup>8</sup> However, as to whether use of the "AQUA GLYDE" mark has been discontinued with the intent not to resume (that is, whether it has been abandoned), Mr. Lewis testified only as follows:

Q Do you know if Allergen has the intent to abandon this Aqua Glyde mark?

A I do not know the answer to that question.

Q Do you know what Allergen's plans are with regard to the Aqua Glyde mark?

A No, sir.

(Lewis dep. at 13.)

Mr. Lewis also developed and choose the mark "AQUA GLYCOLIC" for a skin moisturizing lotion and a non-medicated shampoo. The former, which is marketed as a hand and body lotion, was first sold by Herald in 1983, while the latter was introduced in the mid-1980s. In addition to lotion and shampoo, opposer offers face cream, facial cleanser and astringent under the "AQUA GLYCOLIC" mark. All of such products have been continuously sold under the "AQUA GLYCOLIC" mark and, while often purchased at a physician's recommendation, are targeted for sale to "[g]eneral consumers" through "pharmacies, chain drug, [and] chain stores, such as Walmart". (Id. at 17.) The goods "appear in the personal moisturizers and cleansers and shampoos section of those stores, [as] general toiletries-type products." (Id.)

As to the reason why he selected the marks "AQUA GLYDE" and "AQUA GLYCOLIC," Mr. Lewis testified that:

We wanted to keep continuity within the line, and we had already established the use of Aqua with a couple of other products; in particular, Aquamed and Aqua Lacten. And aqua, the word itself, means water, moisturization. Those are the types of products that we were making.

So it suited the family of products that we were making with respect to Aqua Glyde. That's why it was chosen and, also, with respect to Aqua Glycolic.

(Id. at 29.)

With respect to Herald's "AQUA LACTEN" hand lotion, Mr. Lewis noted that, although he was not the originator thereof, he is familiar with such product, which was developed shortly before he became involved with Herald. While it appears that the

product is no longer sold under the stylized format in which the "AQUA LACTEN" mark was once registered, the record shows that the mark is still in use, in a block letter manner, for hand lotion. Such product, like opposer's "AQUA GLYCOLIC" goods, is sold "[i]n the drug store; in the same general cosmetics, moisturizers, cleansers, toiletries section." (Id. at 21.)

Similarly, while Herald's "AQUAMED" skin lotion was already being sold at the time when Mr. Lewis began his career with Herald, he testified that the "AQUAMED" mark has been in continuous use for such product and is still being sold by opposer. The product likewise is sold "in the pharmacy, [with] shampoos, cleansers, [and] moisturizers." (Id. at 22.)

In addition, during the late 1980s, Herald commenced use of the mark "AQUARAY" in connection with a sunscreen. Mr. Lewis indicated that, like the marks "AQUA GLYDE" and "AQUA GLYCOLIC," he chose the mark "AQUARAY" "to keep it within the family of Aqua products currently being marketed by Herald." (Id. at 30.) The "AQUARAY" mark has been in continuous use for sunscreen and, like the others in opposer's line of skin care products, is sold to "general consumers" through "[p]harmacies, chain drugs, [and] chain stores such as Walmart."<sup>9</sup> (Id.)

Mr. Lewis further testified that, in particular, opposer's "AQUA GLYCOLIC," "AQUA LACTEN" and "AQUAMED" products

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<sup>9</sup> Inasmuch as applicant, in its brief, has raised no objection to opposer's reliance on such testimony, the pleadings are deemed to have been amended, pursuant to Fed. R. Civ. P. 15(b), to include opposer's prior and continuous use of the mark "AQUARAY" for sunscreen." It is pointed out, however, that even if the pleadings had not been deemed to be so amended by the implied consent of the parties, the result in this case would be the same.

are chiefly "sold in the same area, the same general vicinity, in the drug store," with its shampoo being "offset a little bit" from its other goods. (Id. at 23.) He also noted that liquid soaps, such as applicant's "AQUA" liquid bath and toilet soaps, would be sold in the same retail area as opposer's products, since as cleansers for the hands and body, such goods "fit into that personal-care regime." (Id.)

Opposer, as indicated previously, acquired its interest in the marks "AQUA GLYDE," "AQUA GLYCOLIC," "AQUA LACTEN," "AQUAMED" and "AQUARAY" as part of its purchase of the major assets of Herald. In addition, with the exception of its "AQUARAY" mark, all of such marks, their goodwill and any registrations pertaining thereto were formally assigned by Herald to opposer as evidenced by a copy of such assignment, dated August 1, 1995, which has been recorded in the Assignment Division records of the Patent and Trademark Office.

National sales figures for 1997, which is the only year for which Mr. Lewis provided any such figures, were estimated to be \$4,500,000 for opposer's various "AQUA GLYCOLIC" products, \$50,000 for its "AQUA LACTEN" hand lotion and \$30,000 for its "AQUAMED" skin lotion. According to Mr. Lewis, while sales of the latter two products have been flat or "steady" for the past five years, "sales have been increasing" for the "AQUA GLYCOLIC" goods and have done so "dramatically" since about 1994. (Id. at 39-40.) Although opposer advertises its goods, including its various "AQUA GLYCOLIC" products, Mr. Lewis stated that he was not privy to the actual amounts expended. All of opposer's marks

are used on labels and packaging for its goods and, with the exception of its "AQUA GLYDE" mark, also appear in its product catalogs and price lists, which are directed to wholesalers and retailers of its goods rather than to the general consumer.

Turning to consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, we hold that confusion as to the origin or affiliation of the parties' products is likely. Focusing first on the similarities or dissimilarities between the respective goods, we find that applicant's liquid bath and toilet soap are goods which are closely related to opposer's products, including its skin moisturizing lotion, skin cleanser, hand lotion, skin lotion, sunscreen and shampoo. All of such goods are personal-care products or toiletries which, the record shows, would be sold to the same classes of purchasers, including ordinary consumers, through the identical channels of trade, such as pharmacies, chain drug stores, and chain department stores or mass merchandisers. See, e.g., *Ferdinand Mulhens v. Sir Edward Ltd.*, 214 USPQ 298, 300 (TTAB 1981) [toilet soaps and bath soaps found closely related to hair shampoos since such goods "are all of the class commonly referred to as toiletries"] and *Guerlain, Inc. v. Richardson-Merrell Inc.*, 189 USPQ 116, 118 (TTAB 1975) ["hair shampoo and ... soap are closely related products which ordinarily would be purchased in the same retail outlets, whether they be drugstores or department stores, by the same ... purchasers and frequently at the same time during the course of a

shopping trip"]. Applicant, in his brief, does not contend to the contrary. Clearly, if applicant's and opposer's goods, which would be displayed for sale either together with or adjacent to each other in the same retail areas, were to be sold under the same or substantially similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Considering, then, the similarities and dissimilarities between the respective marks, opposer accurately points out that:

Applicant's AQUA mark is identical to the prefix of, and is entirely incorporated in, each of opposer's AQUAMED, AQUA GLYCOLIC, AQUA LACTEN, AQUA GLYDE and AQUARAY marks. As a result, Applicant's mark is visually and phonetically similar to each of Opposer's individual marks.

While opposer concedes that "[t]he 'AQUA' prefix has been used by Opposer because all of the products [it sells] have moisturizing characteristics and 'aqua' suggests water," it is nevertheless the case that applicant's "AQUA" mark, when used in connection with his liquid bath and toilet soaps, likewise suggests water or moisturizing characteristics. In consequence of the similarities in appearance, sound and connotation, applicant's "AQUA" mark and each of opposer's "AQUA GLYCOLIC," "AQUA GLYDE," "AQUA LACTEN," "AQUAMED" and "AQUARAY" marks, when considered in their entirety, projects a substantially similar overall commercial impression.

Applicant contends, however, that confusion is not likely because, as asserted in his brief, "research shows that over 1000 trademarks have been registered using the word aqua, including [those for] soap, skin cleanser, liquid soap, etc."

The record, however, contains no factual support for applicant's argument and, instead, shows that the only marks containing the term "AQUA" and which are registered and/or in use are those which are owned by opposer for its line of skin and hair care products.

We conclude, in light thereof, that customers and prospective purchasers, familiar with opposer's "AQUA GLYCOLIC," "AQUA GLYDE," "AQUA LACTEN," "AQUAMED" and "AQUARAY" marks for, respectively, skin moisturizing lotion and shampoo, skin cleanser, hand lotion, skin lotion, and sunscreen, would be likely to believe, upon encountering applicant's substantially similar "AQUA" mark for his liquid bath and toilet soap, that such closely related toiletry products emanate from, or are otherwise sponsored by or affiliated with, the same source. In particular, applicant's "AQUA" goods are likely to be viewed by the purchasing public as new or additional items in opposer's line of personal-care products.

**Decision:** The opposition is sustained and registration to applicant is refused.

G. D. Hohein

C. E. Walters

H. R. Wendel  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board